

REMARKS/ARGUMENTS

Reconsideration of the above-identified application is respectfully requested.

In the Office Action dated September 14, 2006, claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 4, 6, 8, 9, 13, 14, 16, 17 and 19 are rejected under 35 U.S.C. § 102(e) by U.S. Patent No. 6,711,750 to Yoo (hereinafter "Yoo").

Claims 1-5, 7, and 10-20 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,792,174 to Ioan (hereinafter "Ioan") in view of U.S. Patent No. 6,238,413 to Wexler (hereinafter "Wexler").

In response to the rejections, applicant has amended claims 1, 3-20 and cancelled claim 2. The limitation in claim 2 has been incorporated into the independent claims 1, 13, 16, and 19. The rest of the amendments of the claims are to clarify the invention. No new matter has been introduced.

Applicant acknowledged the receipt of PTO-892 form.

Applicant respectfully submits that the amendments of the claims have obviated the rejections for the reasons set forth below:

Claim Rejections -- 35 U.S.C. § 112

Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner alleges that "[t]he claims include structural limitations based on human anatomy, *i.e.*, the metal member is positioned at Baihui acupoint. This renders the claims indefinite because the location of an acupoint is different for each person. Also, the placement of the metal member depends upon the application by the user. Further, the relative spacing of the plurality of metal members is another variable dependent upon on the spacing of the acupoints

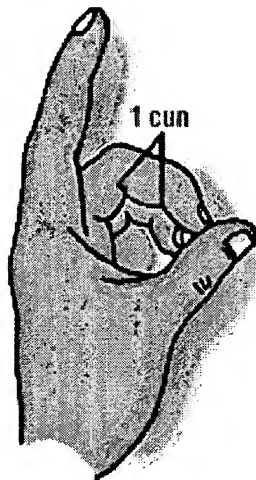
for each individual person. Therefore, the structural limitations of the device dependent upon human anatomy are indefinite.”

Additionally, the Examiner alleges that claims 16-20 include other indefinite terms, such as “second treatment zone” and “third treatment zone.”

With regard to the indefinite allegation that “the metal member is positioned at Baihui acupoint” and/or a treatment zone, Applicant has amended the claims to clarify that “said metal member is fastened to said support member at a location which allows said metal member to be in contact with a Baihui acupoint... when said acupressure device is worn on said human head.” With respect to the “second” and “third” treatment zone, Applicant has delete the word “second” and “third” before the “treatment zone.”

Contrary to the Examiner’s assertion that Applicant’s reference to an acupoint for the location of the metal member in the acupressure device renders the claim indefinite, it is in fact well-known to one of ordinary skill in the acupuncture art that the location of each individual’s acupoint can be accurately measured, or otherwise an acupuncturist would not be able to perform acupuncture on that patient.

For example, Baihui acupoint is known to be located at the intersection between the Du meridian and a line connecting the two upper curvatures of the ears. *See* Specification at 8, lines 9-10 and Figure 1(a) & (b). A user can accurately find his/her Baihui acupoint by first finding out the length of his/her “cun.” When the middle finger is flexed, 1 “cun” is the distance between the radial ends of the two interphalangeal creases of the patient’s middle finger. (*See e.g.*, <http://qi-journal.com/TCMArticles/acumodel/cun.html>):



The “Baihui acupoint” is located at “7 cun above the posterior hairline, midway on a line connecting the apex of both ears, often described as in the ‘twirl’ of the hair.” (*See e.g.*, Exhibit 1; which is taken from <http://qijournal.com/TCMarticles/acumodel/listpoints.asp?token.point=DU20&-token.sea>).

Furthermore, an acupoint is a point (*See* page 10, lines 6-8 of the specification, where “acupoints” is defined as “points, meridian points, acupuncture points, acupressure points, etc.”) which is far much small than a metal member. Therefore, by placing the metal member in the vicinity of an acupoint, the metal point will find its way to be in contact with the acupoint.

Therefore, it does not matter whether the location of an acupoint may be slightly different from person to person, as long as the acupoint of that person can be measured accurately so as to accurately determine the location of the metal member, the claims are definite. Applicant therefore respectfully request that the Examiner withdraw the rejections due to indefiniteness.

Claim Rejection -- 35 U.S.C. § 102

Claims 1, 4, 6, 8, 9, 13, 14, 16, 17, and 19 are rejected under 35 U.S.C. § 102 over Yoo. The Examiner alleges that the claim language, such as “positioned at a Baihui acupoint,” “presses said metal member against said Baihui acupoint,” and “positioned at a plurality of acupoints...” are for “intended use of the device.” Therefore, “[t]he prior art only needs to [be] capable of performing this intended function to meet these limitations.” (See Office Action at 3). Referring to Yoo, the Examiner asserts that “Yoo discloses a supporting member (10) with a plurality of metallic protruding members (32) attached to the inner surface. The device is capable of being applied to a human’s head so that a protrusion is aligned with the Baihui acupoint.” *Id.*

As a preliminary matter, it is undisputable that Yoo never discloses that “the device is capable of being applied to a human’s head.” As a matter of fact, Yoo teaches an “abdominal acupressure belt.” The term “head” or “Baihui acupoint” was never mentioned.

“To anticipate a claim, the reference must teach every element of the claim.” See MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”).

The amended independent claims 1, 13, 16, and 19 make clear that the device claims are not for “intended use.” For example, in the amended claim 1, the metal member is fastened to the supporting member at a location which is in contact with the Baihui acupoint of a human head when the claimed acupressure device is worn on the human head. In other words, the claimed device is a custom-made device where the location of the metal member is justified based on the location of the Baihui acupoint of the person who wears the device. Certainly, Yoo fails to disclose Applicant’s claimed device.

Since Yoo never teaches that its “abdominal acupressure belt” can be used on the human head, and its metal protrusions can be in contact with the acupoint(s) on the human head, which are spaced completely different from those on the abdominal side of the human body, Applicant’s claimed invention is not anticipated by Yoo.

Additionally, should the Examiner assert that Yoo’s invention “inherently” teaches the invention claimed by Applicant, it should be noticed that “Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.” *See Scaltech Inc. v. Retec/Tetra, LLC.*, 178 F.3d 1378, 1384 (Fed. Cir. 1999); *See also Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991).

Therefore, Applicant respectfully submits that Applicant’s amendments have obviated the anticipation rejections over Yoo. A withdrawal of the rejections based on Yoo is respectfully requested.

Claim Rejections -- 35 U.S.C. § 103(a)

Claims 1-5, 7, and 10-20 are rejected under 35 U.S.C. § 103(a) over Ioan in view of Wexler. The Examiner alleges that “Ioan discloses a cap for applying acupressure over a human scalp.” *See* Office Action at 3. The Examiner also acknowledged that “Ioan simply fails to form the protrusions from a metallic material.” *Id.* at 4. However, the Examiner opined that “Wexler teaches that protrusions on an acupressure device for the head can be made of metal as an alternative to rubber and plastic (col. 4, lines 18-20).” *Id.*

However, in Ioan, in addition to the fact that the protrusions are made of non-metallic material, the “natural headache reliever acupressure device has two membranes which define an

enclosed space which can be infused with air. Without the air, the protrusions are not in contact with the human scalp. (*See, e.g.*, Figure 1 of Ioan).

With regard to Wexler, “the two protrusions **112** are caused by two generally semispherical objects placed within the therapeutic pad **110**.” (emphasis added). *See* col. 4, lines 15-16. In addition, the protrusions are on an inner surface of the apparatus. *See e.g.*, Abstract and Figure 3 B. In other words, the protrusions disclosed in Wexler are not in directly contact with the human head.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestio or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) and *MPEP* § 2143.

The amended independent claims 1, 13, 16, and 19 all require that “the metal member is fastened to the supporting member at a location which allows the metal member to be in contact with an acupoint, such as the Baihui acupoint” as in claim 1; and the metal member is made of an electrically conductive metal. That is because “acupoints store charge to a greater degree than surrounding tissues and have lower resistance. Blockages in the normal flow of these currents lead to high concentrations of positive or negative electrical charges that may cause pain and other symptoms of disease.” *See* Specification at 14, lines 2-9. “Patients with pain and dysfunction have a build-up of electrical activity due to impaired circulation.” *Id.*, lines 20-21. Thus, “[t]he large increases in conductivity usually correlate with rapid symptomatic relief of pain and restricted range of motion.” *Id.*, lines 21-22. That is why when the metal member of Applicant’s claimed device is in contact with the skin directly or through the hairs, due to the

conductivity of the metal member, the imbalance of the electrical energy in the acupoint can be corrected through the metal member.

Ioan fails to teach the use of metal member as protrusions, which certainly suggest that Ioan is not in possession of the invention that "metal" member has to be in contact with the acupoint to increase the conductivity of the acupoint for symptomatic relief. The addition of Wexler does not improve the deficiency of the teachings. Wexler, too, fails to teach that the metal member has to be electrically conductive, and has to be in direct contact with the skin or hairs. Therefore, the combined teachings of Ioan and Wexler fail to teach or suggest all of the claim limitations in Applicant's claimed invention.

Therefore, Applicant respectfully requests that the rejections under 35 U.S.C. 103(a) be withdrawn.

In view of the foregoing, Applicant respectfully request that the application be in condition for allowance. Should there be any questions regarding this application, the examiner is requested to contact the applicant's attorney to resolve the problem.

Respectfully submitted,



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